

**REMARKS**

Claims 1-16, 32-36, 40-46 and 76 and 77 are pending, and claims 32-36 and 40-46 are withdrawn from consideration by the Examiner. By this Amendment, claims 17-31, 37-39 and 47-75 are canceled without prejudice to or disclaimer of the subject matter contained therein. Applicants reserve the right to file one or more divisional applications to pursue the canceled claims. Further, new claims 76 and 77 are added. The added new claims are readable on Species I.

Applicants appreciate and thank the Examiner for indicating that claim 14 contains allowable subject matter. However, for reasons as discussed below, it is believed that all of the claims are allowable. Accordingly, reconsideration is respectfully requested in view of the following remarks.

**I. Amendment of Inventorship**

Because of the cancellation of claims 17-31, 37-39 and 47-75 in this Amendment, only Akira OHMURA and Masahide TANAKA are the inventors of the claims in this application. Accordingly, an Amendment of Inventorship under 37 CFR §1.48(b) is filed with this Amendment. Approval of the change in inventorship for the above-identified application is requested.

**II. The Claims Define Patentable Subject Matter**

The Office Action rejects claims 1, 3, 5 and 7 under 35 U.S.C. §103(a) over Aruga (U.S. Patent No. 6,429,896) in view of Misawa (U.S. Patent No. 6,208,380); rejects claim 2 under 35 U.S.C. §103(a) over Aruga in view of Misawa, and further in view of Asakawa (U.S. Patent No. 6,135,809); rejects claims 4, 6 and 11 under 35 U.S.C. §103(a) over Aruga in view of Misawa, and further in view of Koyama (U.S. Patent No. 6,237,106); rejects claims 8 and 9 under 35 U.S.C. §103(a) over Aruga in view of Misawa, and further in view of Niikawa (U.S. Patent No. 6,668,134); rejects claims 10 and 13 under 35 U.S.C. §103(a) over

Aruga in view of Misawa, and further in view of Chatani (JP08069684); rejects claim 12 under 35 U.S.C. §103(a) over Aruga in view of Misawa, and further in view of Morikawa (U.S. Patent No. 5,528,285); and rejects claims 15 and 16 under 35 U.S.C. §103(a) over Aruga, Misawa, Chatani, and further in view of Ikeda (U.S. Patent Publication No. 2002/0106199). The rejections are respectfully traversed.

In particular, neither Aruga nor Misawa, individually or in combination, discloses or suggests an image storage including a built-in memory of a large capacity, as recited in independent claim 1.

Aruga discloses in Fig. 3 and at col. 4, lines 30-55, an external storage device (OM) that includes a removable memory card 5. Other than the removable memory card 5, there is no other memory in the external storage device (see Fig. 3).

Misawa discloses in Figs. 1 and 2, a memory card 12 that can be inserted into, and removed from, a digital camera 10. Specifically, when the digital camera's memory is filled with image data, the memory card can be inserted into a card slot of the digital camera so that the image data stored in the digital camera's memory can be transferred to the memory card (see Abstract of Misawa).

However, neither Aruga nor Misawa discloses or suggests an image storage including a built-in memory of large capacity. The Office Action on page 6 acknowledges that both Aruga and Misawa do not disclose this feature. However, the Office Action asserts that it would be obvious to have the memory integrated into the image storage device as taught by Aruga with a size capacity as needed by the user. Applicants respectfully disagree.

Nowhere does Aruga suggest or provide motivation to construct an image storage with a built-in memory of a large capacity. In fact, because Aruga's image storage uses a removable memory, there is no suggestion or motivation for one skilled in the art to add a built-in memory. Furthermore, in Aruga's image storage, if the removable memory card is not

installed, Aruga's image storage is incapable of storing images. Such is not the case in the claim 1 image storage.

Misawa, on the other hand, does not even disclose an external image storage. In fact, Misawa discloses a removable memory card that is directly inserted into a digital camera. Thus, it would not have been obvious to one skilled in the art to provide an image storage including a built-in memory of large capacity based on the teachings of Aruga and Misawa. The Office Action relies on impermissible hindsight in making this rejection.

Neither Asakawa, Koyama, Niikawa, Chatani, Morikawa nor Ikeda, make up for the above-noted deficiencies of Aruga and Misawa.

Therefore, independent claim 1 defines patentable subject matter. Claims 2-16 depend from claim 1, and therefore also define patentable subject matter. New claims 76 and 77 depend on claim 1, and therefore also define patentable subject matter. Accordingly, withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

### **III. Conclusion**

In view of the foregoing, this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-16, 76 and 77 are earnestly solicited. Rejoinder and allowance of claims 32-36 and 40-46 also is requested.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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MAC:YSC/djb

Attachment: Amendment of Inventorship  
Under 37 C.F.R. §1.48(b)

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